UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,163	01/28/1999	HIROSHI SUMIYAMA	032567-002	6659

21839	7590	02/10/2006

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EXAMINER
POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/238,163	SUMIYAMA ET AL.
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 November 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,4 and 6-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>19 and 23</u> is/are allowed.

6)☒ Claim(s) <u>1,4,6-12,14-18 and 20-22</u> is/are rejected.

7)☒ Claim(s) <u>13</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment was received on 11/14/05, and has been entered and made of record. Currently, **claims 1, 4, and 6-23** are pending.

Response to Arguments

2.   Applicant's arguments, see page 10, filed 11/14/05, with respect to the rejection(s) of claim(s) 1, 4, and 6-19 under 35 U.S.C. 102(e) as being anticipated by Abe (U.S. Patent Number 6,894,792) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kawabuchi *et al.* (U.S. Patent Number 5,740,496).

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   **Claims 1, 4, 6-12, 14-18, and 20-22** are rejected under 35 U.S.C. 102(e) as being anticipated by Kawabuchi *et al.* (U.S. Patent Number 5,740,496)

The applied reference has a common assignee with the instant application. Based upon

the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an appropriate

showing under 37 CFR 1.131.

Regarding *claim 1*, Kawabuchi discloses an image forming apparatus (see abstract, and

Fig. 1) comprising a first memory for storing image data (memory unit 30, column 4, lines 37-

45), an image input unit for inputting the image data to the first memory (column 2, line 55-

column 3, line 49), a second memory for storing image forming conditions (being the

management table MTI stored in the RAM 126, column 4, line 37-column 5, line 7), the image

forming conditions being at least one of number of copies, and magnification (column 3, line 55-

column 4, line 4, and column 4, line 37-column 5, line 7), an image output unit for printing the

image stored in the first memory under the image forming conditions stored in the second

memory (column 6, lines 23-40), a command unit for generating a command of discarding the

image data being printed by the image output unit (see abstract, and column 8, line 49-column 9,

line 16), an image data discarding controller for discarding the image data stored in the first

memory when the command of discarding the image data is generated by the command unit (see

abstract, and column 8, line 49-column 9, line 16), while maintaining the associated image

forming conditions stored in the second memory (column 9, line 17-column 10, line 29), a job

stopping controller for stopping a print operation of a job being printed by the image output unit

(see abstract, and column 8, line 49-column 9, line 16), and an output control unit for causing the

output unit to output image data newly input from the image input unit after the discarding of

image data from the first memory under the maintained image forming conditions (column 3,

line 50-column 4, line 22, and column 9, line 17-column 10, line 29), wherein the command unit

generates a command of discarding the image data of the job stopped by the job stopping

controller (see abstract, and column 8, line 49-column 9, line 16), and wherein the image data

discarding controller discards the image data of the job stopped by the job stopping controller

and maintains the image forming conditions of the job (see abstract, and column 8, line 49-

column 9, line 16).

Regarding *claim 4*, Kawabuchi discloses the image forming apparatus discussed above in

claim 1, and further teaches of means for changing the maintained image forming conditions

(column 3, line 55-column 5, line 7).

Regarding *claim 6*, Kawabuchi discloses the image forming apparatus discussed above in

claim 1, and further teaches that the image input unit is an image reader for reading the image

from the original and acquiring the image data, wherein the image output unit and the image

reader operate independently (column 2, line 55-column 3, line 60).

Regarding *claim 7*, Kawabuchi discloses the image forming apparatus discussed above in

claim 6, and further teaches that when the image reader is reading another original, the command

unit generates a command of suspending the reading operation, and at the same time, it generates

a command of discarding the image data to be printed (see abstract, and Fig. 23, column 9, line

4-column 10, line 29).

Regarding *claim 8*, Kawabuchi discloses the image forming apparatus discussed above in

claim 6, and further teaches that when the image reader is reading another original, the command

unit generates a command of discarding the image data to be printed after the reading operation

for another original has been completed (column 3, line 50-column 4, line 67, and column 8, line

57-column 9, line 16).

Regarding *claim 9*, Kawabuchi discloses the image forming apparatus discussed above in

claim 1, and further teaches that the image output unit is a printer for printing an image on a

paper based on the image data (column 2, line 55-column 3, line 60).

Regarding *claim 10*, Kawabuchi discloses an image forming apparatus (see abstract, and

Fig. 1) comprising an image for reading an original and acquiring image data of the original

(column 2, line 55-column 3, line 49), an image memory for storing image data acquired by the

image reader (memory unit 30, column 4, lines 37-45), a mode memory for storing image

forming conditions selected for the acquired image data (being the management table MTI stored

in the RAM 126, column 4, line 37-column 5, line 7), the image forming conditions being at

least one of number of copies, and magnification (column 3, line 55-column 4, line 4, and

column 4, line 37-column 5, line 7), a printer for printing an image on paper, based on the image

data stored in the image memory, under the image forming conditions stored in the mode

memory (column 6, lines 23-40), a command unit for generating a command of discarding the

image data being printed by the printer (see abstract, and column 8, line 49-column 9, line 16),

an image data discarding controller for discarding the image data stored in the image memory

when the command of discarding the image data is generated by the command unit (see abstract,

and column 8, line 49-column 9, line 16), while maintaining the associated image forming

conditions stored in the mode memory (column 9, line 17-column 10, line 29), a print control

unit for causing the printer to print another image data newly read by the image reader after the

discarding of image data from the image memory under the maintained image forming

conditions in the mode memory (column 3, line 50-column 4, line 22, and column 9, line 17-

column 10, line 29), and a job stopping controller for stopping a print operation of a job being

printed by the printer, wherein the command unit generates a command of discarding the image

data of the job stopped by the job stopping controller (see abstract, and column 8, line 49-column

9, line 16), and wherein the image data discarding controller discards the image data of the job

stopped by the job stopping controller and maintains the image forming conditions of the job

(see abstract, and column 8, line 49-column 9, line 16).

Regarding *claim 11*, Kawabuchi disclose the image forming apparatus discussed above in

claim 10, and further teaches of a changing means for changing the maintained image forming

conditions (column 3, line 55-column 5, line 7).

Regarding *claim 12*, Kawabuchi disclose the image forming apparatus discussed above in

claim 10, and further teaches that the image reader and the printer operate independently

(column 2, line 55-column 3, line 60), and the image memory stores image data for a plurality of

jobs (column 4, lines 22-61).

Regarding *claim 14*, Kawabuchi discloses the image forming apparatus discussed above

in claim 12, and further teaches that when the image reader is reading another original, the

command unit generates a command of suspending the reading operation, and at the same time,

it generates a command of discarding the image data to be printed (see abstract, and Fig. 23,

column 9, line 4-column 10, line 29).

Regarding *claim 15*, Kawabuchi discloses the image forming apparatus discussed above

in claim 12, and further teaches that when the image reader is reading another original, the

command unit generates a command of discarding the image data to be printed after the reading operation for another original has been completed (column 3, line 50-column 4, line 67, and column 8, line 57-column 9, line 16).

Regarding *claim 16*, Kawabuchi discloses an image forming method (see abstract) comprising storing image data in an image memory (memory unit 30, column 4, lines 37-45), storing image forming conditions for the image data in a memory (being the management table MTI stored in the RAM 126, column 4, line 37-column 5, line 7), the image forming conditions being at least one of number of copies, and magnification (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7), printing an image on a paper, based on the image data stored in the image memory, under the image forming conditions stored in the memory (column 6, lines 23-40), generating a command of discarding the image data whose image is being printed (see abstract, and column 8, line 49-column 9, line 16), stopping a print operation of the image data being printed and erasing the image data from the image memory in response to the command (see abstract, and column 8, line 49-column 9, line 16), while maintaining the associated image forming conditions in the memory, acquiring new image data and storing the new image data in the image memory (column 9, line 17-column 10, line 29), and printing a new image on a paper, based on the new image data acquired after the discarding of image data from the image memory, under the image forming conditions maintained in the mode memory (column 3, line 50-column 4, line 22, and column 9, line 17-column 10, line 29).

Regarding *claim 17*, Kawabuchi discloses the image forming method discussed above in claim 16, and further teaches of the step of changing the maintained image forming conditions (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7).

Regarding *claim 18*, Kawabuchi discloses the image forming method discussed above in claim 16, and further teaches of the step of printing image data of another print job on a waiting list after the newly acquired image data has completely been printed (column 3, line 50-column 4, line 22, and column 9, line 17-column 10, line 29).

Regarding *claim 20*, Kawabuchi discloses the image forming apparatus discussed above in claim 1, and further teaches that the storing image forming conditions for the image data in a memory, the image forming conditions being at least one of number of copies, magnification and paper size (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7).

Regarding *claim 21*, Kawabuchi discloses the image forming apparatus discussed above in claim 10, and further teaches that the storing image forming conditions for the image data in a memory, the image forming conditions being at least one of number of copies, magnification and paper size (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7).

Regarding *claim 22*, Kawabuchi discloses the image forming method discussed above in claim 16, and further teaches that the storing image forming conditions for the image data in a memory, the image forming conditions being at least one of number of copies, magnification and paper size (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7).

Allowable Subject Matter

5.   **Claims 19 and 23** are allowed.

6.   **Claim 13** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7.   The following is a statement of reasons for the indication of allowable subject matter:

Regarding *claims 13 and 19*, in the examiner's opinion, it would not have been obvious

at the time of the invention to have the apparatus, as claimed, include the features of print control

unit that gives priority to a new job for printing under the maintained forming conditions over the
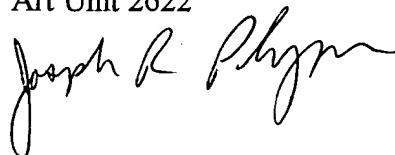
rest of the jobs on a waiting list.

Conclusion

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The

examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622

jrp